

REMARKS

Applicant and his representatives thank Examiner Lewis for the courtesies extended during the interview held on February 20, 2003.

Claims 1-13 were pending. Without prejudice or disclaimer, Applicant has amended independent method claim 1 and canceled claim 9 to delete reference to "elevated blood cholesterol" and intends to pursue this subject matter in a continuation application. Also without prejudice or disclaimer, Applicant has amended independent pharmaceutical preparation claim 11 to recite the specific phytoestrogens previously recited in claim 5 and intends to pursue the deleted subject matter in a continuation application.

Applicant has also added new dependent claims 14 and 15 to cover more specific formulations not previously claimed, but are supported, for example, in original claims 3 and 4. Finally, Applicant has added new independent method claim 16 to encompass the three original indications in independent claim 1, but limited to the use of the phyto-estrogens of original claim 5. New dependent claims 17-19 recite more specific aspects of the method of claim 16, as supported by original claims 6, 7, and 8. Thus, the amendments to the claims and the newly introduced claims are supported by at least the original claims and, accordingly, are fully supported. With the entry of this amendment, claims 1-8 and 10-19 will be pending for examination.

Objections

Applicant acknowledges the Examiner's statement that the "original patent" or a statement "as to loss or inaccessibility" must be received before this reissue application can be allowed. Once the Examiner has found that claims are in condition for allowance, Applicant will submit the original patent.

The Examiner objected to claims 2, 5, 7, 8, and 10 as being dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form. Office Action, page 2, item 3. Applicant appreciates the Examiner's suggestion but has adopted a slightly different approach. Instead of rewriting these claims, Applicant has amended claim 1 to recite the elements of these allowable claims. Thus, claim 1 recites "treating or reducing the predisposition to a condition selected from the group consisting of benign breast disease or cancer of the prostate" and no longer recites "elevated blood cholesterol." Thus, these new claims embody the subject matter found allowable in claims 2, 5, 7, 8, and 10.

Applicant requests reconsideration and withdrawal of the objections.

Rejections Under 35 U.S.C. § 103(a)

The Examiner rejects claims 1, 3, 4, 6, 9, and 11-13 under 35 U.S.C. §103(a) as allegedly obvious over Sharma et al., *Atherosclerosis*, 33:371-375 (1979) ("Sharma"), in view of McCoy et al., U.S. Pat. No. 4,379,177 ("McCoy"). Specifically, the Examiner alleges that "Sharma teaches the a composition comprising two or more of the enumerated phyto-estrogens as being useful for reducing serum total cholesterol." Office Action, page 4, item 7.

Without acquiescing to the rejection, and solely to expedite prosecution, as set forth above, the claims have been amended as indicated above to delete reference to "elevated blood cholesterol." The remaining method claims 3, 4 and 6 now depend from a claim based on the subject matter that the Examiner had indicated was allowable. Claim 9 has been cancelled without prejudice or disclaimer. Finally, Applicant has amended independent pharmaceutical formulation claim 11 to recite the subject matter previously found allowable in claim 5. Accordingly, claims 11-13, as well as new dependent claims 14-15, should also be in condition for allowance.

Thus, claims 1, 3, 4, 6, and 11 through 13 should be in condition for allowance, and Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103.

New Claims

In addition, as set forth above, new independent method claim 16 recites the subject matter found allowable in claim 5. Thus, claim 16 as well as dependent claims 17-19 should also be in condition for allowance.

Conclusion

Applicant respectfully requests reconsideration and withdrawal of all rejections. Further, Applicant requests the timely and expeditious allowance of all pending claims 1-8 and 10-19.

If this Amendment does not put the claims in condition for allowance, Applicant earnestly requests that the Examiner contact the undersigned at 650-849-6676.

Please charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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